

## **REMARKS**

### ***Rejections under 35 U.S.C. § 102(e)***

#### **Claims 132-136, 138**

Claims 132-136, 138 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Munyan, U.S. Patent No. 5,761,485 having a publication/issue date of June 2, 1998.

#### **A. Munyan does not disclose a targeting logic that is external to the player.**

The Examiner countered Applicant's argument that the target logic is external to the player stating that the claims do not recite this limitation. The Applicant respectfully submits that Claim 132 recites this limitation. Specifically, claim 132 recites a computer system comprising targeting logic and download logic. The player is separate from the computer system, because otherwise the computer system would not have download logic to download targeted header and content to the player. Since the computer system is separate from the player, targeting logic residing in the computer system is external to the player. Thus, claim 132 teaches the targeting logic being external to the player, which Munyan does not.

#### **B. Munyan does not disclose a targeted header associated with content.**

Applicant respectfully submits that Munyan discloses using the security identification code to identify a particular personal electronic book unit to the online bookstore. The security identification code is also used to code the removable storage device to a particular personal electronic book unit so that content downloaded to and stored in the removable storage device can only be accessed by the electronic book device unit that downloaded the information from the online bookstore. Thus, Munyan discusses security coding associated with the storage device, not with individual content files.

#### **C. Munyan does not teach downloading targeted header and associated content to the player.**

The Examiner countered Applicant's argument that Munyan does not teach downloading targeted header to the player, and noted that Munyan is ambiguous about who does the security coding, but concluded that a reasonable inference could be made that the bookstore is the one doing the coding.

The Applicant assumes that the Examiner is invoking the principle of inherency. However, the Examiner must provide rationale or evidence tending to show inherency. (MPEP §2112). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Applicant respectfully submits that the Examiner has not provided sufficient rationale or evidence tending to show inherency. In fact, there is evidence that suggests that the bookstore is not the one doing the coding. For instance, Munyan’s Figure 1 illustrates that the online store includes a processing means for handling user requests and downloading content. Munyan is silent as to whether the processing means does anything more than handling user requests and downloading content. The other portions of the online store are telephony means, a storage means, and telephone lines, none of which could possibly conduct security coding.

On the other hand, Munyan discloses that the electronic book device contains a security circuit. Embedded within the security circuit is the electronic book device security code. Thus, the security code is embedded with the electronic book device and is not downloaded from the online bookstore.

Accordingly, Applicant respectfully submits that the invention claims in claims 132-136, 138 is not anticipated by Munyan under 35 U.S.C. § 102(e) and respectfully requests the withdrawal of the rejection of the claims.

***Rejections under 35 U.S.C. § 103(a)***

**Claims 137, 139-144**

Claims 137, 139-144 stand rejected as being obvious over Munyan in view of Ferrel, U.S. Patent No. 6,230,173. Applicant respectfully submits that the combination does not teach each and every element of the invention as claimed in claims 137, 139-144.

Ferrel discloses an online publishing system that separates the content for a multimedia document from the design of the document so that the content can be

presented in various layouts to different users. The contents and layouts are stored in a caching object store on a server or on a user's computer if the document was previously accessed by the user.

Neither Munyan nor Ferrel teaches generating a targeted header associated with content. Also, neither Munyan nor Ferrel teaches downloading targeted header and associated content to the player as claimed. Thus, the combination cannot be interpreted to disclose the claimed element.

Therefore, the combination cannot render obvious Applicant's invention as claimed in claims 137, 139-144, and Applicant respectfully requests the withdrawal of the rejection of the claims over the combination.

#### **Claims 39-53 and 55-131**

Claims 39-53 and 55-131 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ferrel in view of Munyan. Applicant respectfully submits that the combination does not teach each and every element of the invention as claimed in claims 39-53 and 55-131.

#### **Claims 39-53 and 55-109**

The Examiner states that Ferrell does not teach targeting the digital information files using the player ID information and depends on Munyan to teach this limitation.

However, Applicant respectfully submits that Munyan does not teach targeting the digital information files using the player ID information as claimed in claims 39-53 and 55-109. Munyan discusses an electronic book device security code that is used to identify a particular electronic book device unit to the online bookstore. Munyan is silent about encoding the content itself.

#### **Claims 110-131**

With regards to claims 110-131, as neither Ferrell nor Munyan teaches a library server that includes targeting logic to target access to digital information files to a particular mobile device, the combination cannot be interpreted to disclose the claimed element.

Therefore, the combination cannot render obvious Applicant's invention as claimed in claims 39-53 and 55-131, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination

#### **Claims 54**

Claim 54 stands rejected under 35 U.S.C. § 103(a) as being obvious over Ferrell in view of Munyan and Fernandez, U.S. Patent No. 4,855,725. Applicant respectfully submits that the combination is improperly motivated and furthermore does not teach each and every element of the invention as claimed in claim 54.

Fernandez discloses transferring files from a source, such as a read only CD ROM drive, to a portable player connected to a computer upon the computer receiving a unique player identifier from the portable computer.

As none of Munyan, Fernandez, and Ferrell teaches targeting the files with information indicative of the player ID as claimed, the combination cannot be interpreted to disclose the claimed element.

Therefore, the combination cannot render obvious Applicant's invention as claimed in claim 54, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

#### **SUMMARY**

Claims 39-144 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300 x309.

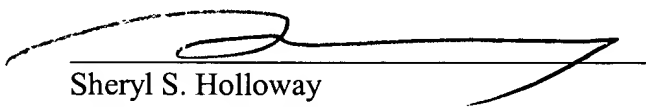
**Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

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